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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEROY W. TILT IV and MATTHEW B. TREVATHAN

Appeal 2008-000874
Application 09/823,331
Technology Center 2400

Decided: September 29, 2009

Before LANCE LEONARD BARRY, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-9 and 11-22, which are all of the claims remaining in this application. Claim 10 has been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm in part.

STATEMENT OF THE CASE

The Invention

Appellant's invention relates to web servers. More particularly, the invention on appeal relates to software for controlling the order of serving supplemental files that form a part of a requested Web page. (Spec. 1, ll. 4-7).

Claim 1 is illustrative:

1. A method of serving a Web page to a requesting client, said Web page comprising code defining said Web page and including a plurality of supplemental files, said method comprising the steps of:
 - parsing said code defining said Web page to detect order data within the code that indicates an order in which said supplemental files are to be served, said order data comprising data other than the order in which said supplemental files appear in said code defining said Web page;
 - constructing a queue indicating said order;
 - serving said code to said requesting client;
 - serving said supplemental files to said client in said order indicated in said queue.

Prior Art

The Examiner relies on the following references as evidence:

Krishnan	US 6,073,124	Jun. 6, 2000
Anders	US 6,269,403 B1	Jul. 31, 2001

The Examiner's Rejection

The Examiner rejected claims 1-9 and 11-22 under 35 U.S.C. § 103(a) as unpatentable over the combination of Anders and Krishnan.

APPELLANTS' CONTENTIONS

1. Appellants contend the secondary Krishnan reference does not teach that for which it was cited. (i.e., "parsing said code defining said web page to detect order data within the code that indicates an order in which supplemental files are to be served") (App. Br. 15).

2. Appellants contend that the Examiner's proffered motivation for combining the references is improper. (*Id.*).

3. Appellants contend that Anders discloses the information that indicates the order in which objects are to be displayed is "user supplied." (Reply Br. 5 and App. Br. 18-19).

4. Regarding independent claim 9, Appellants contend that the cited references fail to teach or suggest the recited second code associated with each of said references and comprising *an attribute of a tag associated with said supplemental file*. (App. Br. 20, emphasis added).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Have Appellants shown the Examiner erred in determining that the cited references teach or suggest "parsing said code defining said web page to detect order data within the code that indicates an order in which

supplemental files are to be served?” (Independent claim 1; *see* the commensurate language recited in independent claims 12 and 19).

2. Have Appellants shown the Examiner erred in determining that the cited references teach or suggest code (i.e., order data) indicating an order that comprises an attribute of a tag, as required by the language of independent claim 9 and also recited in commensurate form in dependent claims 7, 17, and 21?

PRINCIPLES OF LAW

Obviousness

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Having acknowledged that certain claimed elements are taught by the prior art, Appellants cannot now defeat an obviousness rejection by asserting that the cited references fail to teach or suggest these elements. *See Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988) (“A statement in a patent that something is in the prior art is binding on the applicant and patentee for determinations of anticipation and obviousness.”); *In re Nomiya*, 509 F.2d 566, 571 n.5 (CCPA 1975) (It is a “basic proposition that a statement by an applicant, whether in the application or in other papers submitted during prosecution, that certain matter is ‘prior art’ to him, is an admission that that matter is prior art for all purposes”).

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellants' Briefs to show error in the Examiner's proffered prima facie case.

FINDINGS OF FACT

In our analysis *infra*, we rely on the following findings of fact (FF):

Admissions by Appellants

1. Appellants admit that Anders "does, in fact, disclose a technique for ordering the serving of supplemental files of the present invention." (App. Br. 18).
2. Appellants admit that Anders discloses receiving a pre-existing stored web page and parsing it. (*Id.*).

Anders

3. Anders teaches information that is a part of the pseudo-code that describes a template 214. (Col. 10, ll. 17, 37-40).
4. Anders teaches sequence numbers of object data. (Col. 11, ll. 18-21).

Krishnan

5. Krishnan teaches parsing HTML code (i.e., HTML objects) in a web page for display. (Col. 4, ll. 5-9).

ANALYSIS

Issue 1

Claims 1-6, 12-16, 19, and 20

We decide the question of whether the cited references teach or suggest “parsing said code defining said web page to detect order data within the code that indicates an order in which supplemental files are to be served.” (Independent claim 1; *see* the commensurate language recited in independent claims 12 and 19).

As noted above, Appellants contend that Krishnan, which was relied upon by the Examiner to teach the aforementioned limitation, does not teach that for which it is cited. Assuming *arguendo* that this is the case, it is our view that Appellants have admitted that this limitation is taught or suggested by Anders. (FF 1-2; *see also Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d at 1570; *In re Nomiya*, 509 F.2d at 571 n.5).

We view Krishnan as a cumulative reference to the extent that we agree with Appellants that Krishnan teaches the conventional parsing and serving of HTML code (i.e., HTML web page objects) for display in the order in which the HTML objects are encountered by the parser. (FF 5; *see also* App. Br. 17, ¶1). Because we consider Krishnan as a cumulative reference, we consider Appellants’ argument regarding the Examiner’s proffered motivation to combine as moot. (*See* App. Br. 15).

As admitted by Appellants, Anders teaches a technique for ordering the serving of supplemental files of the present invention. (FF 1 and App. Br. 18). However, Appellants contend that Anders’ teaches that the user provides the order or sequence of the objects (supplemental files). (App. Br.

18-19). Therefore, Appellants aver that Anders does not teach or suggest the claimed invention. (App. Br. 19). We do not find Appellants' arguments to be persuasive for the reasons discussed *infra*.

We find that the language of independent claim 1 (and the commensurate language of independent claims 12 and 19) does not preclude the order data from being user-supplied, as long as it is a part of the "code defining the web page," as claimed. We further find that according to Anders, the display sequence information is a part of the pseudo-code of a template (i.e., code defining the web page) (FF 3). Regarding Appellants' contention that there are no sequence numbers in Anders (App. Br. 19), we find that Anders does in fact teach sequence numbers of object data. (FF 4).

Regarding the further disputed limitations of constructing a queue where the queue comprises an ordered list of supplemental files (App. Br. 21), we find such an arrangement is nothing more than the predictable use of prior art elements according to their established functions. *See KSR*, 550 U.S. at 417. Appellants have provided no evidence showing that such a familiar element or arrangement (ordered queue or list) would have been "uniquely challenging or difficult for one of ordinary skill in the art." *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418-19).

Based on the record before us, we find Appellants have not shown the Examiner erred in establishing a prima facie case of obviousness regarding the aforementioned disputed limitations. Accordingly, we sustain the Examiner's obviousness rejection for claims 1-6, 12-16, 19, and 20.

Issue 2

Independent claim 9 and dependent claims 7, 8, 11, 17, 18, 21 and 22

We decide the question of whether the cited references teach code (i.e., order data) indicating an order that comprises an attribute of a tag, as required by the language of independent claim 9, and also recited in commensurate form in dependent claims 7, 17, and 21. Based upon our review of the evidence before us, we agree with Appellants' contention that the Examiner has not established that the prior art teaches or suggests that the data identifying the display order comes from an attribute of a tag. (See App. Br. 20).

Therefore, we find Appellants have shown error in the Examiner's rejection of independent claim 9. Accordingly, we reverse the Examiner's rejection of claim 9, as well as claim 11 which depends therefrom. For the same reason, we also reverse the Examiner's rejection of dependent claims 7, 17, and 21. In addition, we reverse the Examiner's rejection of claims 8, 18, and 22 that depend from claims 7, 17, and 21, respectively.

CONCLUSIONS

Appellants have not established that the Examiner erred in rejecting claims 1-6, 12-16, 19, and 20 under 35 U.S.C. §103(a).

Appellants have established that the Examiner erred in rejecting claims 7, 8, 9, 11, 17, 18, 21 and 22 under 35 U.S.C. §103(a).

DECISION

We affirm the Examiner's decision rejecting claims 1-6, 12-16, 19, and 20, under 35 U.S.C. §103(a).

We reverse the Examiner's decision rejecting claims 7, 8, 9, 11, 17, 18, 21 and 22 under 35 U.S.C. §103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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